



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,981	06/14/2001	Robert C. Covington JR.	11421/5	5066
23838	7590	11/18/2004	EXAMINER FILIPCZYK, MARCIN R	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			ART UNIT 2161	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/879,981	COVINGTON ET AL.	
	Examiner	Art Unit	
	Marc R Filipczyk	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004 and 27 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-14 and 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Action is responsive to Applicant's RCE request filed August 27, 2004 and amendment received June 1, 2004.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2004 has been entered.

Claims 1 and 15-21 are cancelled, claims 2-14 and 22 are amended, and new claims 15-21 are submitted, thus claims 2-14 and 22-28 are pending.

#### ***Election/Restrictions***

Examiner has conducted a telephone interview with David R. Schaffer on March 19, 2004 wherein the Applicants elected Group I, claims 2-14 with traverse. Applicants have now formally elected Group I without traverse (6/1/2004).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2161

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-14 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Weil et al (US 2003/0093409) in view of Foulger et al (U.S. Patent No. 6,578,022).

Regarding claims 2, 7-11 and 23, Weil discloses a method, system and network for providing a user-specific response, the system comprising (fig. 1, items 104, 120 and 130 Weil):

receiving an inquiry from a user; (fig. 2, items 136 and 210, Weil)

receiving a search profile by a subscriber via said network (fig. 1, items 118 and 136 and page 2, par. 17, Weil)

associating the user with a search profile designated by a subscriber on a network; (fig. 2, 214, Weil)

conducting a search delimited by the search profile in a database on the network; (fig. 1, item 118, fig. 2, 220, and related text, Weil)

providing a search result to the user; (fig. 2, 240, Weil)

reporting the search result to the subscriber; (fig. 2, 250, Weil) and,

receiving a request for additional information from the user; (fig. 2, page 3, par. 22 lines 1-11, page 4, par. 27, lines 1-5, Weil), and that content files may include all the information provided by an online educational service, but Weil does not explicitly teach an expert system.

However, Foulger teaches an interactive intelligent searching system (title, Foulger) wherein an expert is in contact with a user in response to a user's request (fig. 1, items 110, 125 and 135, Foulger). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an expert in Weil as used in Foulger by

Art Unit: 2161

interconnecting the expert to the internet network of Weil (fig. 1, 120, Weil). One would have been motivated to use an expert in the Weil system to provide answers to customer requests not contained in the content files and databases.

Regarding claims 3 and 25, Weil/Foulger disclose indexing the inquiry to pre-defined search terms (page 4, par. 34, lines 1-10, Weil).

Regarding claims 4 and 26, Weil/Foulger disclose the inquiry is made by selecting at least one topic from a plurality of pre-defined topics (fig. 1, 120, Foulger).

Regarding claims 5 and 27, Weil/Foulger disclose the search profile is pre-defined by the subscriber (fig. 1, 118 and fig. 2, 214, Weil).

Regarding claims 6 and 28, Weil/Foulger disclose that conducting a search comprises accessing one or multiple databases (fig. 1, 150 and associated text, Weil).

Regarding claims 12 and 13, Weil/Foulger disclose updating a database to include the consultant's response (fig. 1, 115, Foulger).

Regarding claim 14, Weil/Foulger disclose the network subscriber designates the consultant (fig. 1, 125 and 135).

Art Unit: 2161

Regarding claims 22 and 24, Weil/Foulger disclose the inquiry is in natural language form (fig. 1, 104, 108, 110, 114, Weil).

### ***Response to Arguments***

Applicant's arguments filed on June 1, 2004 and RCE of August 27, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicants argue on page 9 of the 6/1/04 response that Weil does not teach "receiving a request for additional information from the user."

In response to Applicant's arguments, Examiner disagrees. It appears that Applicants have misunderstood Weil system. Referring to fig. 1, Weil discloses an interactive search system wherein search requests are modified between Users and a Search Engine Interface (page 4, par. 27). Note the language used in the cited paragraph specifically stating "the search process **may** continue with the transmittal of a search request 210 from the client 104, 110 to the server 130" and "for further processing" indicating that the search system (figures 1-3) is a loop, has no stop, quit or exit conditions and is interactive. For a more detailed explanation please refer to the rejections above and Weil, paragraphs [0021-0031]. Examiner notes that interactive search systems are well known to one of ordinary skill in the software art and that most search systems since 1990 and newer are interactive.

Applicant argues on page 9 of the 6/1/04 response that Weil does not teach "forward the inquiry to a consultant in response to a request for further information by the user."

Art Unit: 2161

In response to Applicant's arguments, Examiner disagrees. The notion of a user inquiring further information Examiner believes has already been addressed in the above response, however, specifically regarding the term "consultant", that portion of the claim is relied on Weil in view of Foulger, wherein Foulger discloses and teaches an expert system which is equivalent to a consultant. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

No other matters have been raised.

With respect to all the pending claims 2-14 and 22-28, Examiner respectfully traverses Applicant's assertion based on the discussion and rejections cited above.

### ***Conclusion***

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is (571) 272-4019.

The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

Art Unit: 2161

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

November 12, 2004



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
BIOLOGY CENTER 2100